

### REMARKS

Currently, Claims 2, 7-13, 16, 21-27, 30, 35-41 and 43-45 remain pending in the present application. Of these claims, Claims 9, 23 and 37 are independent claims and the remaining claims all depend from one of Claims 9, 23 and 37, either directly or through intervening claims. These claims all stand rejected under 35 U.S.C. § 103 as obvious in light of the combination of United States Patent No. 5,835,726 to Shwed *et al.* (hereinafter "Shwed") in view of United States Patent No. 6,009,459 to Belfiore *et al.* (hereinafter "Belfiore").

To establish a *prima facie* case of obviousness, the Patent Office must satisfy three requirements. First, the prior art reference or combination of references must teach or suggest all of the limitations of the claims. *See In re Wilson* 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art"). Second, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *In re Fine*, 837 F.2d at 1074; *In re Skinner*, 2 U.S.P.Q.2d 1788, 1790 (Bd. Pat. App. & Int. 1986). Third, the proposed modification or combination of the prior art must have a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *See Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *See* M.P.E.P. § 2143. Moreover, to support combining references in a Section 103 rejection, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement is not met by merely offering broad, conclusory statements about teachings of references. *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Finally, as discussed in M.P.E.P. 706.02(j) it is important that the basis for a rejection be communicated properly so that an applicant is given a fair opportunity to respond to the rejection. Furthermore, it is also important that the written record be

clear as to the rationale behind decisions made during the prosecution of a patent. M.P.E.P. 706.02(j). Such is the case because the rationale behind decisions in a case may affect the claim scope of an issued patent and, absent a clear explanation of how references are applied in a particular case, the applicant will not be provided a fair opportunity to address or rebut the rationale of the examiner.

### **The Claims Are Patentable Over Shwed and Belfiore**

Turning now to the specifics of the rejections, Claim 9 provides an example of the recitations of the pending independent claims. In particular, Claim 9 states:

9. (Amended) A method of **controlling content provided to a device** of a user of a network, the method comprising:  
providing session dependent information associated with the device to a network device having stored policies which are based on the session dependent information; and  
automatically **modifying the content provided by the network device to the device** based on the policies and the provided session dependent information so as to **modify the content provided to the user of the device**.

(emphasis added). Similar recitations are found in Claims 23 and 37. As is clear from the highlighted portions of Claim 9, the present invention provides for the network device that modifies the content provided to a device so as to modify the content provided to a user of the device. Thus, the content provided to the device of the user is controlled. This content modification must occur at a device other than the device of the user and be based on the stored policies and the session dependent information. Otherwise, the content **provided to** the device of the user would **not** be controlled.

The Final Official Action acknowledges that Shwed fails to teach modifying the content provided to the device of the user so as to modify the content provided to the user of the device but asserts that Belfiore provides such a teaching. Final Official Action, p. 3. Belfiore relates to automatic searching for resources in a distributed environment. Belfiore, Abstract. Applicants submit that neither Belfiore nor Shwed, either alone or in combination, disclose each of the recitations of the independent claims. Furthermore, Belfiore may not be properly combined with Shwed to result in the recitations of Claims 9, 23 and/or 37.

Neither Belfiore nor Shwed disclose or suggest "modifying the content provided by the network device to the device based on the policies and the provided session dependent information so as to modify the content provided to the user of the device" as recited in the independent claims. The Final Official Action cites to the abstract, Figure 8B, column 7 lines 6-35 and Claims 14 and 42 of Belfiore for such a teaching. However, the abstract of Belfiore describes a web search tool which either retrieves a URL entered by a user or creates a search based on the URL if no website is found corresponding to the URL entered by the user. Belfiore, Abstract. There is no mention of modifying content provided by a network device based on session dependent information or policies of the network device. All of the actions described in the abstract of Belfiore occur at the device with the browser.

Similarly, in Belfiore, the only discussion of "content" being altered occurs at the client and is not based on policies of the network device or session dependent information. *See* Belfiore, Fig. 8 and discussion thereof. As is clear from the discussion in Col. 7 of Belfiore, the client opens the web page and may highlight search terms. Such is not modification of the content provided to the device by the network device as is recited in the claims. The altering of content described in Belfiore only occurs at the client and, therefore, does not disclose or suggest the network device modifying the content provided by the network device to the device of the user, as is recited in the claims. Accordingly, the cited combination of Shwed and Belfiore fail to disclose or suggest each of the recitations of independent Claims 9, 23 and 37.

Furthermore, Applicants submit that there would be no reason to combine the teachings of Shwed and Belfiore. The reasoning in the Final Official Action is that such a combination would be obvious because "this would have ensure that the user receive the particular content selected in the search session." Final Official Action, p. 3. However, it is unclear from the Final Official Action how, or why, the teachings of Shwed, could or would be modified by the URL based search and/or retrieval of Belfiore to result in the recitations of Claims 9, 23 and 37. Shwed describes formatting of packets, for example, to encrypt, decrypt or digitally sign the data packets, irrespective of the actual content provided by the data packets which is unrelated to URL searches as described in Belfiore.

Shwed does not alter the content provided to a user based on session dependent information and, in fact, has no need to modify the content of the packets. At most, Shwed modifies the format of data packets provided to a user's device. Similarly, Belfiore has no need to modify the content of packets based on policies or session dependent information, as Belfiore only describes highlighting web content after it is received at the client. Thus, even if combined, Belfiore and Shwed would not result in the recitations of Claims 9, 23 and 37.

Furthermore, Shwed relates to firewall or network address translation operations while Belfiore relates to web browser user interfaces. One of skill in the art would not look to the user interface art for solutions to the firewall/address translation problems of Shwed and, likewise, would not look to the firewall/address translation art to solve the user interface problems of Belfiore. As such, Shwed and Belfiore may not be properly combined. Accordingly, Applicants submit that independent Claims 9, 23 and 37 are not obvious in light of Shwed and Belfiore and request withdrawal of the present rejection. Applicants further submit that the remaining claims are patentable at least per the patentability of their base claims.

Claims Depending from Claims 9, 23 and 37 are Separately Patentable

While each of the claims which depend from Claims 9, 23 and 37 are patentable as depending from a patentable base claims, certain of the dependent claims are separately patentable over Shwed and Belfiore. Applicants discussed several of these claims in Applicants' previous Amendment. However, the Final Official Action fails to even address these arguments. This is the case even though Applicants specifically requested clarification as to basis of the rejection of these dependent claims. The Final Official Action does not cite to Belfiore as teaching the recitations of the dependent claims but simply reiterates the previous rejections with no further explanation. As such, Applicants submit that the Final Official Action has failed to establish a prima facie case of obviousness as required by M.P.E.P. 706.02(j) and, therefore, request allowance of the dependent claims.

For example, Claims 10, 24 and 38, each recite that the modification of the content comprises "automatically **translating content** of a communication provided to the device associated with the user **from a first language to a second language.**"

The Final Official Action completely ignores the recitations of the claims that the translation is from one language to another and merely states that Shwed teaches "automatically translating content of a communication provided to the device." Final Official Action, p. 3. There is no discussion in Shwed at all about translating from a first language to a second language. As discussed above, Shwed relates to firewalls. Thus, Shwed would have no reason to perform language translation on the content of data provided to a user. Accordingly, Applicants submit that Claims 10, 24 and 38 are separately patentable for at least these additional reasons. However, should the Examiner maintain this rejection, Applicants request that the Examiner explain how the cited portion of Shwed teaches the recitations of these claims.

Claims 11, 25 and 39 depend from Claims 10, 24 and 38 and, therefore, are separately patentable for the reasons discussed above. However, these claims also recite that the session dependent information from which the determination of whether to modify the content to translate from one language to another is "at least one of a type of network connection, a type of device connected to the network, a user identification of the user and an identification of an application executed by the user." Shwed does not disclose or suggest basing such a language translation on one or more of: the network connection; the type of device; a user identification; and/or an identification of an application. As such, Applicants submit that Claim 11, 25 and 39 are separately patentable for at least these additional reasons.

Claims 7, 21 and 35 further recite that the policies for modification of content are stored on a second network accessible device and are obtained in response to the network device being provided the session dependent information. In contrast, the cited portion of Shwed does not describe policies that are stored on a second network device and used by a first network device or that the policies are obtained from the second network device **in response to the network device being provided the session dependent information**. See Shwed, col. 3, lines 8-35 and col. 14, line 40 to col. 15, line 42. In fact, Shwed expressly recites that "each firewall maintains a rule base that instructs the firewall how to handle both inbound and outbound communications between network objects." Shwed, col. 14, lines 62-65. Thus, Shwed expressly states that the rules are stored locally, not on a second network accessible device, as recited in Claims 7, 21 and 35. Furthermore, because the rules

are stored locally, there would be no reason to obtain them responsive to receiving the session dependent information. Accordingly, Applicants submit that Claims 7, 21 and 35 are separately patentable for at least these additional reasons.

Claims 8, 22 and 36 each recite that the second network accessible device is an on-demand server. No such disclosure is found in Shwed and the Final Official Action does not even address the recitations of these claims. Accordingly, Applicants submit that Claims 8, 22 and 36 are separately patentable for at least these additional reasons.

Claims 12, 26 and 40 each recite that "the policies comprise policies which control at least one of characteristics of a network connection, characteristics of content associated with a device utilized by the user, and preferences associated with an application utilized by a user." Shwed does not suggest using policies for the control of the items identified in these claims. Accordingly, Applicants submit that Claims 12, 26 and 40 are separately patentable for at least these additional reasons.

Claims 43 through 45 each recite that the content controlled is at least one of "removing color components of the content, removing graphics information to provide text-only content, prioritizing communications and varying preferences for an application." Applicants submit that such a modification of content is neither disclosed nor suggested by the cited references. In particular, the cited portion of Shwed says nothing about any of the recitations of Claims 43 through 45, but only addresses firewall issues. There is no discussion of color components, graphics, communication prioritization or application preferences. Accordingly, Applicants submit that Claims 43 through 45 are separately patentable over the cited references for at least these additional reasons. However, should the Examiner maintain these rejections, Applicants request that the Examiner explain how the cited portion of Shwed teaches the recitations of these claims.

### **Conclusion**

Having addressed each of the issues raised in the Final Official Action, Applicants submit that the present application is in condition for allowance, which action is respectfully requested.

In re Application: C *et al.*  
Serial No.: 09/211,527  
Filed: December 14, 1998  
Page 8 of 8

Respectfully Submitted,



Timothy J. O'Sullivan  
Registration No.: 35,632

USPTO Customer No. 20792  
Myers Bigel Sibley & Sajovec  
Post Office Box 37428  
Raleigh, North Carolina 27627  
Telephone (919) 854-1400  
Facsimile (919) 854-1401

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box AF, Commissioner for Patents, Washington, DC 20231, on October 25, 2001.



Traci A. Brown

Date of Signature: October 25, 2001